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Docket No. 50325-0553 (Seq. No. 4494)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Confirmation No.: 6237

Alan CONLEY, et al. **RECEIVED** : Group Art Unit: 2171

Serial No.: 09/886,851 **JAN 28 2004** : Examiner: Etienne LEROUX

Filed: June 20, 2001 **OFFICE OF PETITIONS**

Title: AUTOMATICALLY GENERATING REPLICATION TOPOLOGY INFORMATION
FOR USE BY A DIRECTORY SERVICE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Technology Center 2100

PETITION UNDER RULE 181

TO ACCEPT ANTEDATING AFFIDAVIT UNDER RULE 131

Applicants respectfully petition the Commissioner under 37 C.F.R. §1.181 to invoke his supervisory authority and to direct the Examiner to accept an antedating affidavit of the inventors filed in this application on October 31, 2003 under 37 C.F.R. §1.131.

I. PROCEDURAL SUMMARY

A. First Action and Reply

Applicants filed this application on June 21, 2001. The Office mailed a first action on August 5, 2003, stating a restriction requirement, and rejecting of claims based on U.S. Pat. App. 2002/0065941 (Kaan). Applicants filed a timely reply on October 31, 2003 addressing the restriction requirement and the claim rejections. The reply included a declaration of the inventors under 37 C.F.R. §1.131 establishing conception and reduction to practice long prior

to the effective date of Kaan, but without stating specific dates of conception and reduction to practice.

B. Final Action and Interview

The Office mailed a second, final action on January 9, 2004 (Paper No. 6) that indicated that the Rule 131 affidavit¹ is ineffective to overcome the Kaan reference for the following reasons: "Ineffective, Insufficient Evidence of Conception"; "Ineffective, Insufficient Evidence of Reduction to Practice"; "Ineffective, Diligence Lacking."

An "Examiner's Assessment" of the affidavit beginning on page 21 of the Office Action alleged the following: (A) Applicant had not complied with the formal requirements of 37 CFR 1.131, because Applicant did not address conception of the invention nor diligence in reduction to practice; (B) Applicants' statements regarding dates are ambiguous, because dates are redacted from Exhibit 1 and Exhibit 2; (C) It is unclear to what the "true date" referenced in the affidavit pertains, i.e., conception or reduction to practice; (D) Affidavit has not obviated the 35 U.S.C. 102(e) rejection as being anticipated by Kann, because Applicant has not proven a conception date and diligence in reduction to practice of the present invention.

A telephonic interview was conducted on January 14, 2003. The participants were Examiner Etienne Leroux and John D. Henkhaus, representative of record. Applicants' representative initiated the interview to discuss the Examiner's Assessment and to seek an informal resolution with respect to the Rule 131 affidavit.

¹ The Office Action refers to the Applicants' declaration as an affidavit. Although an affidavit and a declaration are different in substance and legal effect, the terms are considered interchangeable for purposes of this Petition.

In the interview, Applicants' representative discussed two basic issues that appeared to be Examiner's reasons for rejecting the declaration. First, Applicants' representative addressed the scope of the affidavit. In particular, Applicants' representative stated that the declaration and associated exhibits establish actual reduction to practice of the invention before the effective date of the Kaan reference, and that Applicants are not seeking and are not required to establish conception coupled with diligence leading to the reduction to practice. Second, Applicants' representative addressed the Examiner's statements about the absence of specific dates of conception in Exhibit 1 and Exhibit 2 to the affidavit. No agreement was reached with respect to the sufficiency and propriety of the declaration.

The Applicants' representative requested, but the Examiner refused, a telephonic interview with the Examiner's supervisor present. Applicants submitted an Interview Summary on January 16, 2004.

II. ARGUMENT

A. A Rule 181 Petition is Proper Relief for Refusal to Accept a Rule 131 Affidavit.

A petition to review an Examiner's decision with respect to the sufficiency and propriety of an affidavit filed under 37 C.F.R. §1.131 is properly presented as a petition to invoke the Commissioner's supervisory authority under 37 C.F.R. §1.181. See MPEP 1002.02(c)(3)(d).

B. The Rule 131 Affidavit Is Sufficient and Proper to Show Reduction to Practice of the Invention Before the Effective Date of the Kaan Reference.

Allegations (A), (C) and (D) of the Examiner's Assessment improperly rejected the Rule 131 affidavit for failing to establish conception coupled with diligence. Applicants' declaration properly establishes an actual reduction to practice of the invention prior to the

effective date of the reference. Establishing actual reduction to practice alone is sufficient for a declaration or affidavit to properly antedate a reference.

Establishing *only* an actual reduction to practice is sufficient to antedate a reference under Rule 131. The rule requires a showing of facts to “establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence ...” (emphasis added). 37 C.F.R. §1.131(b). The two clauses in the rule are in the disjunctive, separated by or. Thus, the rule specifically allows for an affidavit to establish only reduction to practice of the invention to antedate a cited reference.

The effective date of Kaan as a reference is October 2, 2000, which is the date of provisional patent application 60/237,211 to which Kaan claims priority. Paragraph 3 of the declaration states that the declaration is made for the purposes of establishing that a functioning version of a computer program that embodies the invention disclosed and claimed in the present application was created in the United States prior to October 2, 2000. Paragraph 4 of the declaration states that a functioning version of the subject invention was created prior to October 2, 2000. Paragraph 5 of the declaration states that the “repl-gen” computer program was a functioning version of a computer program that embodies the subject invention. Thus, the declaration establishes an actual reduction to practice, in the form of a computer program (“repl-gen”) that embodies the inventive features described and claimed in the application, as evidenced at least by Exhibit 1, which includes output from a functioning version of the repl-gen computer program generated prior to October 2, 2000.

The existence of a reduction to practice of embodiments of an invention is a legal conclusion that the Applicants/Affiants are not qualified to make in a fact declaration. Therefore, in the declaration Applicants/Affiants refer instead to a date by which the

“functioning version of the computer program” and the “functioning version of the subject invention” were created. The date is a fact to which the Applicants/Affiants, as designated inventors, are qualified to declare. A reduction to practice is “a physical embodiment which includes all limitations of the claim.” UMC Elec. Co. v. United States, 816 F.2d 647, 651 (Fed. Cir. 1987), *cert denied* 484 U.S. 1025 (1988). Evidence proving the existence of a functioning version of the computer program is necessarily probative of a reduction to practice of the subject invention. Hence, the evidence presented in Exhibit 1 and Exhibit 2 of the affidavit is probative of a reduction to practice of the subject invention prior to October 2, 2000. See Declaration, ¶¶6-7; Response filed October 31, 2003, at 17.

Furthermore, the statements of facts presented throughout the affidavit are much more than general allegations, and are sufficient to satisfy the factual requirements of Rule 131.

For the foregoing reasons, it is improper to reject the affidavit as insufficient or improper for failure to establish conception and diligence as well as actual reduction to practice. The declaration and attached evidence have been clearly presented as probative of actual reduction to practice of the subject invention, and includes statements of facts relevant to establishing such a reduction to practice.

Applicants respectfully request a finding that the affidavit and associated evidence is, on its face, presented as probative of a reduction to practice and contains sufficient statements of facts to meet the formal requirements of 37 C.F.R. §1.131, and that a rejection or disposition of the affidavit on grounds relative to conception and diligence is improper.

C. The Rule 131 Declaration Properly Omitted Specific Dates Alleged to Show an Actual Reduction to Practice of the Invention Before the Effective Date of the Kaan Reference.

Applicants’ declaration includes attached evidence in which actual dates are redacted or blocked out. In Allegation (B) of the Examiner’s Assessment, the Office Action

improperly rejected the Applicants' declaration for failing to allege specific dates of actual reduction to practice. Further, during the telephone interview, the Examiner stated that any evidence presented with the actual dates of relevant events redacted would be insufficient to establish anything for this Examiner. In fact, the Examiner referred to a redacted document as a "blank check," even though the Applicants' declaration avers that the true dates of the redacted documents are long prior to October 2, 2000. The Examiner expressed concern that with this "blank check", Applicants could continue to antedate any new reference that the Examiner may find and cite against the application.

The Examiner's concern is misplaced and is not a proper basis for refusing a Rule 131 declaration. "The PTO is required to accept Rule 131 Affidavits at face value, and without investigation." 1 Chisum, *Patents* Section 3.08 [1] [a] (Matthew Bender 1995); Herman v. William Brooks Shoe Co. (S.D. N.Y. 1996) 39 USPQ2d 1773, 1777. Applicants/Affiants may either allege the actual date of the invention or state that the specified acts occurred prior to a specified date. *See Chisum, supra; see also Ex parte Gasser*, 1880 C.D. 94 (1880). The practice of redacting actual dates, in evidence supporting a reduction to practice, is specifically addressed and provided for in MPEP 715.07, "Establishment of Dates," which requires presentation of actual dates only for establishment of diligence. Since Applicants' declaration addresses only reduction to practice, a showing of actual dates is not required.²

² The use of Rule 131 declarations with evidence having dates blocked out is a common, decades-old, valid procedure. The practice recognizes, as one rationale, that an applicant who discloses specific dates of conception or reduction to practice would suffer a great disadvantage in an interference, because the applicant's adversary could decide whether to request an interference and select evidence calculated to ensure that the adversary is declared as senior party. Indeed, Rule 131 contemplates declarations that include no evidence at all, by providing that the absence of evidence could be "satisfactorily explained." 37 C.F.R. §1.131.

The Examiner seems to suggest that accepting a declaration with redacted dates could potentially enable a malicious applicant to falsify evidence. Such a concern mocks the solemnity of a declaration that is made with knowledge and acknowledgement of penalties under 18 U.S.C. §1001, and the consequences to a registered practitioner for presenting a false declaration.

The present Applicants/Affiants cannot and would not willfully make such declarations if false. Applicants/Affiants are only able to antedate references that their acts, in fact, precede. There is inherent credibility to any and all facts that are declared in an affidavit, when made with knowledge and acknowledgement of penalties under 18 U.S.C. §1001. To ignore such inherent credibility and to summarily dismiss such declarations and evidence as too ambiguous to prove anything is a clear abuse of the discretion granted an examiner in evaluation of such declarations and evidence contained in affidavits under 37 CFR 1.131.

III. CONCLUSION

For all the foregoing reasons, the Office Action improperly refused to accept the propriety and sufficiency of Applicants' Rule 131 Declaration to antedate the Kaan reference. The Office is requiring an affidavit to disclose actual dates of acts that establish reduction to practice, but long-standing affidavit practice under Rule 131 clearly allows for a redaction of dates from documents submitted in support of an affidavit.

Applicants respectfully petition the Commissioner under 37 C.F.R. §1.181 to invoke his supervisory authority and to direct the Examiner to accept an antedating affidavit of the inventors filed in this application on October 31, 2003 under 37 C.F.R. §1.131. Applicants specifically request that a decision granting this petition should include a finding that Applicants' Rule 131 declaration and evidence is probative of a reduction to practice and is



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sufficient to establish completion of the invention and reduction to practice prior to the
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effective date of the Kaan reference.

The Office is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the consideration of this petition.

A check in the amount of \$130.00 for the fee set forth in 37 CFR 1.17(h) is provided. Please charge any deficiency of fee or credit any overpayment to Deposit Account No. 50-1302.

Respectfully Submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: 1/21/04

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450

on 1/21/04 by Clare Fung

Docket No. 50325-0553 (Seq. No. 4494)

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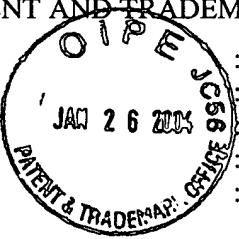
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P.O. Box 1450

Technology Center 2100

Alexandria, VA 22313-1450

Dear Sir:

TRANSMITTAL

Transmitted herewith is a Petition under Rule 181 to Accept Antedating Affidavit under Rule 131 in the above-identified application.



No additional fee is required.



Also attached: Check in the amount of \$130.00 for the Petition fee under C.F.R. 1.17(h)
Postcard.

Please charge any deficiency of fee or deposit any overpayment to Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

By:

John Henkhaus

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CERTIFICATE OF MAILING

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on January 21, 2004

by Clare L